

REMARKS/ARGUMENTS

The Office Action mailed November 3, 2005 has been reviewed and carefully considered. Claims 1, 4-5, and 7-11 are pending in this application, with claim 1 being the only independent claim. Reconsideration of the above-identified application, as herein amended and in view of the following remarks, is respectfully requested.

Claim Amendments

Independent claim 1 is amended to recite that the "a connecting element held in a bore defined in said piston rod guide, a longitudinal direction of said bore being approximately parallel to a longitudinal direction of said working cylinder". Support for this limitation is found in Fig. 1 which shows the length of the bore as parallel to the length of the working cylinder. Independent claim 1 is further amended to recite "a bushing defining a side of a circumferential groove in said bore, and a resilient securing ring arranged in said groove". Support for this limitation is found in claim 6; Figs. 3-6; and paragraph 0017 of the application.

Claims 2-3 were previously canceled. Claim 6 is amended to be consistent with the amendments to independent claim 1. Claims 4-5 and 8 are amended to depend from independent claim 1.

Rejection of the Claims Under 35 U.S.C. §103

Claims 1 and 4-11 stand rejected under 35 U.S.C. §103 as unpatentable over U.S. Patent No. 3,945,663 (Duckett) in view of U.S. Patent No. 4,240,654 (Gladieux).

Independent claim 1 recites "a connecting element held in a bore defined in said piston rod guide, a bushing inserted into and fixed directly to a side of said bore in said piston rod guide, said bushing defining a side of a circumferential groove in said bore, and a resilient securing ring arranged in said groove, wherein said connecting element is connected to said

enclosed envelope and non-detachably inserted into said bore in said piston rod guide for connecting said enclosed envelope to a flow connection".

It is respectfully submitted that the combined teachings of Duckett and Gladieux discloses the above limitations because the combined teaching fail to disclose (1) a connecting element for an envelope held in a bore defined in a piston rod guide, a longitudinal direction of said bore being approximately parallel to a longitudinal direction of the working cylinder, and (2) a connecting element received in a bore with a bushing defining a side of a groove with the bore.

Regarding the first reason, the Examiner acknowledges in the Office Action that Duckett discloses a strut with an enclosed envelope connected to an inlet but lacks the connecting element recited in independent claim 1. Applicant respectfully submits that Duckett also fails to teach or suggest that the enclosed element has a connecting element "held in a bore defined in said piston rod guide". In contrast, Duckett discloses a feed nipple 23 connected through the side wall of a suspension strut. The feed nipple 23 includes a head 24 with a threaded stem 26 which projects through a hole in the envelope or sac and through a hole in the outer cylinder 2 (col. 3, lines 29-34). The threaded stem is inserted through a mounting bush 27 and held thereon by a nut 28 screwed onto the projecting end of the threaded stem (col. 3, lines 32-35). There is no teaching or suggestion in Duckett that the feed nipple can be connected to a bore in the piston rod guide because Duckett fails to teach or suggest how the feed nipple 23 can be connected to the envelope at the end of the envelope facing the piston rod guide.

The Examiner alleges that it would be obvious to modify Duckett so that the feed nipple 23 is connected to a bore in piston rod guide. However, Duckett teaches only that the feed nipple 23 is connected to a side of the envelope and arranged through a hole in the wall of the

outer cylinder 2 (see col. 3, lines 29-34). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Only the present application teaches an envelope with a connecting element that is held in a bore in the piston rod guide.

Gladieux fails to teach or suggest what Duckett lacks. Gladieux discloses a hose end coupling unit (see col. 1, lines 5-8 of Gladieux). Since Gladieux discloses only the connection of a coupling to a hose, Gladieux fails to teach or suggest anything about connecting a an envelope in a piston-cylinder assembly of a suspension system for a motor vehicle to a piston rod guide of the piston-cylinder assembly. Duckett and Gladieux are devoid of any teaching or suggestion for "a connecting element held in a bore defined in said piston rod guide, a longitudinal direction of said bore being approximately parallel to a longitudinal direction of said working cylinder" and "wherein said connecting element is connected to said enclosed envelope and non-detachably inserted into said bore in said piston rod guide for connecting said enclosed envelope to a flow connection", as expressly recited in independent claim 1. "To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome in which that which only the inventor taught is used against its teacher." *See W.L. Gore & Assocs. V. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983). Since the disclosures of Duckett and Gladieux fail to fail to provide any motivation for a connecting element held in a bore in a piston rod guide, it is respectfully submitted that independent claim 1 is allowable over Duckett and Gladieux.

Regarding the second reason, the teaching of Duckett and Gladieux also fail to disclose "a bushing defining a side of a circumferential groove in said bore", as expressly recited in independent claim 1. The Examiner acknowledges that Duckett fails to disclose the claimed connector. However, Gladieux also fails to disclose, teach or suggest the claimed subject matter. As shown in Figs. 1-6 of Gladieux, the grooves 41 and 71 are formed in a one piece socket fitting 30. If the socket fitting 30 is machined, the grooves must be formed by an expanding tool. If the socket fitting is cast, the grooves must be formed by mold which have to be removed. There is no disclosure, teaching, or suggestion in Gladieux for a bushing in the bore forming a groove. The Examiner acknowledges that Gladieux does not disclose a bushing and merely states that such a feature is known in the art. In a previous office action, the Examiner referred specifically to Cunningham. However, Applicant refuted that reference in the previous amendment filed on October 11, 2005. Accordingly, if this rejection is to be maintained, Applicant respectfully requests a cited example of prior art showing the claimed configuration.

In view of the above amendments and remarks, it is respectfully submitted that independent claim 1 is allowable over Duckett in view of Gladieux.

Dependent claims 4-11, each being dependent on independent claim 1, are allowable for at least the same reasons as is independent claim 1, as well as for the additional recitations contained therein.


Dependent claim 11 further recites that the "bore is a drilled hole, said groove being defined by said bore and said bushing". It is respectfully submitted that neither Duckett nor Gladieux discloses this limitation.

The application is now deemed to be in condition for allowance and notice to that effect is solicited.

It is believed that no fees or charges are required at this time in connection with the present application. However, if any fees or charges are required at this time, they may be charged to our Patent and Trademark Office Deposit Account No. 03-2412.

Respectfully submitted,

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